



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/596,001	06/16/2000	Elfi Biedermann	69176	2626

22242 7590 09/24/2003

FITCH EVEN TABIN AND FLANNERY
120 SOUTH LA SALLE STREET
SUITE 1600
CHICAGO, IL 60603-3406

EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT	PAPER NUMBER
----------	--------------

1624

DATE MAILED: 09/24/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicant(s)

09/596,001

Applicant(s)

BIEDERMANN ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-8, 12, 14, 24, and 32-50 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 2-8, 12, 14, 24, and 32-50 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's amendment has been entered. Due to the broad scope of the claims, the following restriction is deemed necessary for a more proper and meaningful search.

Claims 2-8, 12, 14, 24, and 32-50 are pending.

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 2-8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula

I with the following substituents:

R^1 and R^2 do not form a bridge;
A is not a ring; E is piperazinyl (or $q = 1$);
G is G^1 ,

and their preparation, composition, and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

- II. Claims 2-8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula

I with the following substituents:

R^1 and R^2 do not form a bridge;
A is not a ring; E is piperazinyl (or $q = 1$);
G is $G(2a)$,

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

III. Claims 2-8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula

I with the following substituents:

R^1 and R^2 do not form a bridge;

A is not a ring; E is piperazinyl (or $q = 1$);

G is $G^{(2b)}$,

and their preparation, composition and methods of treatment, classified in class

514, subclass 253.01, and class 544, subclass 360.

IV. Claims 2-8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula

I with the following substituents:

R^1 and R^2 do not form a bridge;

A is not a ring; E is piperazinyl (or $q = 1$);

G is G^3 ,

and their preparation, composition and methods of treatment, classified in class

514, subclass 253.01, and class 544, subclass 360.

V. Claims 2-4, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of

formula I with the following substituents:

R^1 and R^2 do not form a bridge;

A is not a ring; E is piperazinyl (or $q = 1$);

G is G^4 ,

and their preparation, composition and methods of treatment, classified in class

514, subclass 253.01, and class 544, subclass 360.

VI. Claims 2-4, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of

formula I with the following substituents:

R^1 and R^2 do not form a bridge;

A is not a ring; E is piperazinyl (or $q = 1$);

G is G⁵,

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

- VII. Claims 2-4, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula I with the following substituents:

R¹ and R² do not form a bridge;
A is 1,2-cyclopropylene; E is piperazinyl (or q = 1); G is G¹,

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

- VIII. Claims 2-4, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula I with the following substituents:

R¹ and R² do not form a bridge;
A is 1,2-cyclopropylene; E is piperazinyl (or q = 1); G is G(2a),

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

- IX. Claims 2-4, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula I with the following substituents:

R¹ and R² do not form a bridge;
A is 1,2-cyclopropylene; E is piperazinyl (or q = 1); G is G(2b),

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

Art Unit: 1624

- X. Claims 2-4, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula I with the following substituents:

R^1 and R^2 do not form a bridge;

A is 1,2-cyclopropylene; E is piperazinyl (or $q = 1$); G is G^3 , and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

- XI. Claims 2-4, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula I with the following substituents:

R^1 and R^2 do not form a bridge;

A is 1,2-cyclopropylene; E is piperazinyl (or $q = 1$); G is G^4 , and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

- XII. Claims 2-4, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula I with the following substituents:

R^1 and R^2 do not form a bridge;

A is 1,2-cyclopropylene; E is piperazinyl (or $q = 1$); G is G^5 , and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

- XIII. Claims 2, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula I with the following substituents:

R^1 and R^2 form a bridge;

E is piperazinyl (or $q = 1$); G is G^1 ,

Art Unit: 1624

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

XIV. Claims 2, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula

I with the following substituents:

R^1 and R^2 form a bridge;
E is piperazinyl (or $q = 1$); G is G(2a),

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

XV. Claims 2, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula

I with the following substituents:

R^1 and R^2 form a bridge;
E is piperazinyl (or $q = 1$); G is G(2b),

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544 subclass 360.

XVI. Claims 2, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula

I with the following substituents:

R^1 and R^2 form a bridge;
E is piperazinyl (or $q = 1$); G is G^3 ,

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.04, and class 544, subclass 360.

XVII. Claims 2, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula

I with the following substituents:

Art Unit: 1624

R^1 and R^2 form a bridge;
E is piperazinyl (or $q = 1$); G is G^4 ,

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

XVIII. Claims 2, 8, 12, 14, 24, and 32-50 (part of each), drawn to compounds of formula

I with the following substituents:

R^1 and R^2 form a bridge;
E is piperazinyl (or $q = 1$); G is G^5 ,

and their preparation, composition and methods of treatment, classified in class 514, subclass 253.01, and class 544, subclass 360.

XIX. Claims 2, 8, 12, 14, 24, and 32-50 (part of each), drawn to the remaining

compounds of formula I (not included in the above groups, e.g., $q = 2$ or 3, etc.),

and their preparation, composition and methods of treatment, classified in various classes, and subclasses.

The inventions are distinct, each from the other because of the following reasons:

Inventions of groups I through XIX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions represented by the compounds of each group can be used independently, and are not combination/subcombination of each other.

Art Unit: 1624

Although the compounds of groups I-XIX share a pyridyl (or pyridyl-N-oxide) ring, the combination of substituents R¹, R², A, E, and G sets each group apart. A search on a mere substituted pyridyl or pyridyl-N-oxide ring would yield an exorbitant number of hits. Thus, a burden of searching exists even though groups I-XVIII share the same class and subclass.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (5:00-12:30) & every Saturday morning (starting from 4-7-03).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.



T. Truong

September 21, 2003

Art Unit 1624

JEAN F. VOLLANO
PRIMARY EXAMINER

